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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TM Bioscience Corporation

Serial No. 76485778

Ellen S. Simpson of Simpson & Simpson PLLC for TM Bioscience Corporation.

Linda M. Estrada, Trademark Examining Attorney, Law Office 103 (Thomas G. Howell, Managing Attorney).

Before Hairston, Walters and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

TM Bioscience Corporation seeks registration on the Principal Register of the mark TAG-IT for goods identified in the application as follows:

> "diagnostic preparations for research use, namely mutation detection kits composed of reagents and protocols used in the determination of particular genotypes in samples of nucleic acid," in International Class 1; and
>
> "diagnostic preparations for clinical use, namely mutation detection kits composed of reagents and protocols used in the determination of particular genotypes in samples of nucleic acid," in International Class 5.[1]

[1] Application Serial No. 76485778 was filed on January 29, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has held that applicant's mark, when used in connection with the identified goods, so resembles the mark TAGIT registered in connection with "N-hydroxysuccinimidyl 3-(4-hydroxyphenyl) propionate," in International Class 1, as to be likely to cause confusion, to cause mistake or to deceive.[2]

Applicant and the Trademark Examining Attorney fully briefed the case. Applicant did not request an oral hearing. We affirm the refusal to register as to both classes of goods.

In arguing for registrability, applicant argues that its goods are different from those of registrant and that they will travel in different channels of trade. Furthermore, applicant argues that the consumers are

[2] Registration No. 1031862 issued on February 3, 1976, Section 8 affidavit approved and Section 15 affidavit acknowledged; renewed. Additional modifying language in the identification of goods of the cited registration as issued ["an ester particularly adapted for the iodination labeling of peptides and proteins"] that was referenced both by the Trademark Examining Attorney and by applicant appears to have been deleted at some point from the identification of goods.

different, and that consumers of both products are highly sophisticated individuals and/or companies.

By contrast, the Trademark Examining Attorney takes the position that these goods are related, may well travel in the same channels of trade to the same classes of purchasers, whose alleged sophistication may not help them to avoid confusion as to the source of these related goods.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to a consideration of the similarities and/or dissimilarities in the marks, we find that the presence of a hyphen in applicant's mark provides for a negligible difference in appearance. The two terms are identical as to sound. As to connotation, whether TAGIT/TAG-IT is used in the context of a labeling product or a mutation detection kit, the term has the same

suggestive connotation for both products. We note that applicant has not spent a great deal of its time during the course of prosecuting this application arguing this *du Pont* factor to the contrary. Accordingly, when comparing the marks in their entireties, we find that the marks create substantially identical overall commercial impressions.

We turn next to the *du Pont* factor focusing on the relationship of the goods. In this context, as argued by the Trademark Examining Attorney, if the marks of applicant and registrant are substantially identical, the relationship between the respective goods need not be as close in order to support a finding of likelihood of confusion as might apply where more significant differences exist between the marks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981).

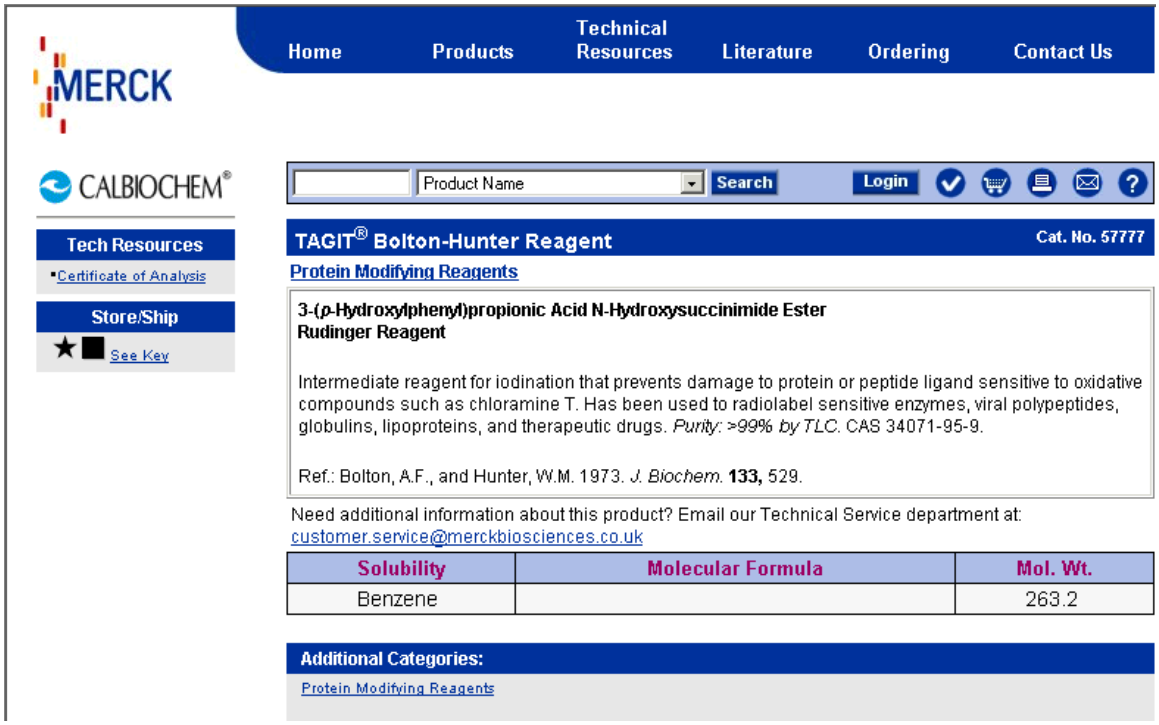
Applicant summarizes in a table what it argues are clear differences between these two products:

REGISTRANT'S **TAGIT®**	APPLICANT'S **TAG-IT™**
• Chemical	• Diagnostic kit
• Labeling proteins – organic reagent	• Genotyping – Nucleic Acid Mutation Detection
• Research Labs	• Clinical Genetic Labs
• Single container	• Packaged kit of several tubes, software and product insert
• Solid chemical (requirement to suspend)	• Several tubes of liquid reagent
• General research reagent	• Targeted marketing to diagnostic labs

Applicant correctly states our black letter law when it argues that the nature and scope of a trademark owner's products must be determined on the basis of the specific goods recited in the application or registration. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). However, in trying to understand the specific goods involved, we must review the record as a whole to determine whether the evidence supports the Trademark Examining Attorney's contention that these goods are related. Both applicant and the Trademark Examining Attorney have properly made of record webpages that present extrinsic evidence in an effort to clarify the nature of registrant's goods – not to attempt an improper limitation of registrant's identification of goods. *In re Trackmobile*, 15 USPQ2d 1152, 1153-54 (TTAB 1990).

Registrant's identified product [N-hydroxysuccinimidyl 3-(4-hydroxyphenyl) propionate] is a chemical compound. Although the modifying language appears to have been deleted from the identification of goods in the cited registration [" … an ester particularly adapted for the iodination labeling of peptides and proteins."], we cannot read this amendment as resulting in a broader scope, or different set, of goods than that which existed at the time

of registration. In fact, despite this amendment to the cited goods, the word "ester" appears to be a generic designation for this category of chemical compounds. This chemical compound falls into the general category of protein-modifying reagents, and it is used specifically for fluorescent and radiolabeling of nucleic acids, proteins and oligonucleotides. Originally described by Rudinger and Ruegg,[3] it is also known as the "Bolton-Hunter Reagent,"[4] and under the cited trademark, this reagent shows up in the record on a Merck / CalBiochem webpage, as follows:



[3] Rudinger, J., and Ruegg, U., *Biochem.J.* 133:538 (1973).
[4] Bolton, A.E., and Hunter, W.M., *Biochem.J.* 133:529 *(1973).*

According to the record, companies such as Pierce,[5] PerkinElmer[6] and Roche Diagnostics[7] also market this type of chemical reagent. Irrespective of the vendor, these active esters are directed to scientists doing basic research in gene expression, functional genomics and proteomics (i.e., the study of the structures and functions of proteins), all within university life science research departments, the biotechnology/pharmaceutical industries and other commercial laboratories.

In arguing for registrability herein, applicant describes its product as follows:

> "Diagnostic kits used in the detection of nucleic acid mutations. Multiple reagents make up the kit. There is a menu of several different mutation detection kits under the Tag-It brand name that identify different sets of disease-related polymorphisms. The method for analysis of the nucleic acid is referred to as the Tag-It Mutation Detection assay. Performance of the Tag-It assay specifically determines the genotype of a sample of nucleic acid."

Applicant placed its identified goods in two classes, International Classes 1 and 5. Registrant's goods and applicant's "diagnostic preparations for research use" are classified in International Class 1 as are chemical

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5 http://www.piercenet.com/
6 http://www.perkinelmer.com/
7 http://www.roche-diagnostics.com/

products generally used in industry and science. Applicant's "diagnostic preparations for clinical use" are correctly classified in International Class 5 along with other *in vitro* diagnostic chemicals for clinical diagnostic purposes. We note that in both classes of goods, applicant's "diagnostic preparations," or "mutation detection kits," are composed of "reagents" and "protocols." In short, while applicant's kits do include software on a CD-ROM and a package insert, they are predominantly tubes of industrial chemicals.

In looking closely at applicant's identified goods, we agree with applicant that these kits are not products that compete with registrant's chemicals. Customers for registrant's chemicals are research labs buying a solid reagent in a single container. The labs buying applicant's goods are purchasing a kit containing smaller tubes of liquid reagents. These kits would necessarily be very specific in nature, each containing materials for identification of one or more specific genetic mutations.[8]

While it seems clear that both products would be used in biological research at the molecular level (e.g., both

[8] For example, applicant's Tag-It™ CFTR 40+4* assay simultaneously screens for the twenty-five cystic fibrosis gene mutations http://www.tmbioscience.com/prodlist.php?id=389; and applicant's Tag-It™ P450-2D6 provides detection of twelve nucleotide variants http://www.tmbioscience.com/prodlist.php?id=338.

involving nucleic acids), it is likely that each would be used by researchers answering quite different questions. Customers of applicant's products will be trying to detect genetic variations, including mutations, in human genes. Customers of registrant's product will be doing basic medical research on proteins and protein chemistry.

Applicant argues that the Trademark Examining Attorney has illogically focused on the single word "reagents." As noted above, "reagents" do appear to represent significant components of applicant's identified kits. The webpages show applicant's reagents to include ingredients like PCR primer mixes, bead mixes and wash buffers (e.g., detergents and reducing agents). While the word "reagents" does not appear in registrant's identification of goods, it does appear in registrant's Internet homepage, *supra*, discussing the product sold under the TAGIT mark. Many of the third party registrations placed into the record by the Trademark Examining Attorney simply show the words "reagents" and "labeling" in the same listing of goods. We agree with applicant that it would be improper to find these respective goods related on this connection alone.

In fairness, the Trademark Examining Attorney actually concludes that the goods herein are related based upon more

than just the presence of "reagents" in both sets of goods. Rather, the Trademark Examining Attorney argues based upon the totality of the evidence in the record -- the identifications of goods in registrant's registration and applicant's application; the webpages of registrant, of applicant, and of third-party companies such as Roche Diagnostics, PerkinElmer, Inc., Chemicon International Inc., and Mirus Corporation[9]; as well as from third-party federal trademark registrations – that mutation detection kits for research use and clinical use may well originate from the same source as regents used in labeling. In spite of this contention, we cannot find in the record a single vendor marketing mutation detection kits for research use and clinical use as well as chemical regents used in labeling.

Nonetheless, that is neither the standard to which the Office is held in showing a relationship of the goods, nor is it the end of our inquiry. As contended by the Trademark Examining Attorney, the fact that the goods of the parties may differ is not controlling in determining likelihood of confusion. The issue is not likelihood of

[9] http://www.mirusbio.com/ lists its biochemical, dual-labeling system for microarray applications, *Label* IT® µArray™ as a one-step labeling reagent for scientific / research use having dyes and reagents that detects small changes in gene expression. DNA and RNA labeling

confusion between particular goods, but likelihood of confusion as to the source of those goods. *See In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984), and cases cited therein.

On the face of the two identifications of goods, both of these products could be used in genomics, proteomics and biological research. And while applicant repeatedly stresses the words "diagnosis," "diagnostic," and "diagnostics," in discussing its product and channels of trade, we also note that some of applicant's involved genotyping kits specifically say that they are "For Research Use Only. Not for use in diagnostic procedures."[10] Hence, we are reluctant to conclude on this record that we are faced with unrelated goods moving in totally separate channels of trade.

Furthermore, although there are clearly differences in these products, we cannot help but note from applicant's webpages, press releases, and the like, made of record, from LEXIS/NEXIS evidence and third-party Internet sites, as well as from Merck / CalBiochem (registrant's) webpages, the overlap of the involved technologies growing out of recent research around the human genome. Specifically,

[10] http://www.tmbioscience.com/prodlist.php?id=336; http://www.tmbioscience.com/prodlist.php?id=338

Nobel-prize winning genetic analysis technology of the polymerase chain reaction (PCR) figures prominently in the literature of both products.[11] One learns from this record that PCR is a technique for amplifying DNA, making it easier to isolate, clone and sequence. PCR has led to significant advances in basic research as well as in the diagnosis of important diseases from AIDS to cystic fibrosis.

Moreover, we find that applicant's history tracks the substantial commercialization in the field of clinical genetics. This history reflects the fact that genetic diagnostic services, once provided almost exclusively through academic, not-for-profit medical centers, have become the province of for-profit corporations. For example, applicant alleges that it provides a large volume of its goods to Quest Diagnostics, an enterprise, which in turn, touts itself as "The nation's leading provider of diagnostic testing, information, and services." There is nothing in the record to suggest that these for-profit clinical genetics diagnostics companies do not continue to

[11] For example, one of the key reagents in applicant's kits is a "PCR primer mix." Registrant's webpages show that PCR is related to its DNA labeling products.

maintain business and/or research relationships with academia.

As noted earlier, based on this record, we are not convinced that a single party sells mutation detection kits and the "Bolton-Hunter Reagent." On the other hand, the record demonstrates that some of the same vendors will market both labeling products and reagents included as key components of applicant's mutation detection kits.

By analogy, perhaps these complex biotech products are different from each other in much the same way that a hammer is different from a pair of wire cutters. Both are tools, but inasmuch as one is used in construction and the other in electrical wiring, neither one would be very effective in accomplishing the other's task. Nonetheless, if identical marks were to be used on both of these hand tools, confusion as to source would be likely. Similarly, the test before us is not whether one would confuse a labeling product with a mutation detection kit. Rather, the issue is whether one who knows of registrant's product would mistakenly believe applicant's product comes from the same source. It is sufficient for purposes of the instant determination that the goods are related in some manner such that they would be likely to be encountered by the

same persons under circumstances that could, because of the marks used thereon, give rise to the mistaken belief that they originate from or are in some way associated with the same source. *See Hilson Research Inc. v. Society for Human Resource Management,* 27 USPQ2d 1423 (TTAB 1993). Here, we find that the goods of applicant and registrant, as identified in the application and registration, are related closely enough that their contemporaneous marketing under the same or similar marks would be likely to cause confusion as to source.

As to the related *du Pont* factor focusing on channels of trade, applicant's identification of goods (e.g., "diagnostic preparations for research use…") does not restrict its channels of trade to "diagnostic laboratories in hospitals or commercial diagnostic laboratories." (Applicant's reply brief, p. 4) While the record does not show a single vendor marketing both products, we find that the respective goods are nonetheless related. Moreover, we find that both products might well be directed toward the same general class of customers, namely life science researchers as a group. We acknowledge that any one physician, scientist or researcher may be focused on a narrow subject matter area, and the Trademark Examining

Attorney has not presented any specific situations in which both products would be used simultaneously in a given project. However, we would not find it surprising that the same purchaser, such as a lab technician within a life sciences laboratory, might well work with both products, namely, tissue marking products (or fluorescent labels) and mutation detection products, and particularly the component reagents from the latter kits that may be replaced from a source other than applicant.

Applicant argues that its consumers are sophisticated and unlikely to be confused. While sophisticated lead researchers may well be knowledgeable about the source of particular materials, even such sophisticated users may be confused as to source by substantially identical marks. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Moreover, even if one agrees that such sophisticated end-users are knowledgeable about the products, it does not necessarily mean that the actual purchaser is knowledgeable. The technical staff of a laboratory, including those responsible for ordering replacement goods, may not exercise such a high degree of deliberation in their product selections, and may well not be as

knowledgeable as the lead researchers, and this could well lead to misplaced ordering. We are convinced from this record that individuals ordering materials for a lab would come across both products, and could mistakenly assume a common source.

As to the *du Pont* factor focusing on the number and nature of similar marks in use on similar goods, applicant has made no argument that this term is in any way weak on this type of biotechnology product. Despite the fact that the term TAGIT may be suggestive of both applicant's and registrant's respective goods, even suggestive marks are entitled to protection against registration of a substantially similar mark used in connection with closely related goods. *See In re Textron Inc.*, 180 USPQ 341 (TTAB 1973).

In summary, we find that the marks are substantially identical as to overall commercial impression, that TAGIT has not been shown to be a weak mark in the field of biotechnology products, that the goods are related, and could well move through the same channels of trade to the same classes of consumers.

Finally, to the extent there is any doubt on the issue of likelihood of confusion, we follow the well-established

principle that such doubt must be resolved in favor of the registrant and prior user. *In re Mayco Mfg.*, 192 USPQ 573, 576 (TTAB 1976).

Decision: The refusal to register applicant's mark under Section 2(d) is hereby affirmed.